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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/026,773

12/27/2001

Matthew Rozek

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22428

7590

10/05/2006

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EXAMINER

RIES, LAURIE ANNE

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.		Applicant(s)	
	10/026,773		ROZEK ET AL.	
	Examiner		Art Unit	
	Laurie Ries		2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16, 18, 20-36, 38 and 40-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18, 20-36, 38 and 40-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This action is responsive to communications: Response after Final Rejection, filed 23 December 2005, to the original application filed 27n December 2001.
2. Claims 1-3, 7-16, 18, 20-23, 27-36, 38, 40-42, and 45-46 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Eck (U.S. Publication 2002/0129059 A1) in view of Bhatt (U.S. Patent 6,799,184 B2, filed 30 January 2002, and claiming priority from U.S. Provisional application no. 60/300,573, filed 21 June 2001).
3. Claims 4, 24, 43, and 47 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Eck (U.S. Publication 2002/0129059 A1) in view of Bhatt (U.S. Patent 6,799,184 B2, filed 30 January 2002, and claiming priority from U.S. Provisional application no. 60/300,573, filed 21 June 2001) and Webber (U.S. Patent 6,418,400 B1).
4. Claims 5 and 25 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Eck (U.S. Publication 2002/0129059 A1) in view of Bhatt (U.S. Patent 6,799,184 B2, filed 30 January 2002, and claiming priority from U.S. Provisional application no. 60/300,573, filed 21 June 2001), Webber (U.S. Patent 6,418,400 B1) and Huang (U.S. Publication 2002/0147748 A1).

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5. Claims 6, 26, 44, and 48 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Eck (U.S. Publication 2002/0129059 A1) in view of Bhatt (U.S. Patent 6,799,184 B2, filed 30 January 2002, and claiming priority from U.S. Provisional application no. 60/300,573, filed 21 June 2001) and De La Huerga (U.S. Patent 6,516,321 B1).

6. Claims 1-16, 18, 20-36, 38, and 40-48 are pending. Claims 1, 21, 41, and 45 are independent claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-3, 7-16, 18, 20-23, 27-36, 38, 40-42, and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eck (U.S. Publication 2002/0129059 A1) in view of Bhatt (U.S. Patent 6,799,184 B2, filed 30 January 2002, and claiming priority from U.S. Provisional application no. 60/300,573, filed 21 June 2001).**

**As per independent claims 1 and 21**, Eck discloses a computer readable medium on a computer system and a method for translating between an XML-type document and a first type of document, in the form of a flat file, including generating a data model for the XML-type document based on an XML data source (See Eck, Page 4, paragraph 0075), and generating a data model for the first type of document based on the XML data source (See Eck, Page 4, paragraph 0075).

Eck also discloses storing the data model for the XML-type document, the data model for the first type of document, and the mapping rules in the storage device (See Eck, Page 2, paragraph 0038).

Eck does not disclose expressly that mapping rules are created between the data model for the XML-type document and the data model for the first type of document and verifying that the XML-type document is well-formed based upon the data model for the XML-type document. Bhatt discloses the creation of mapping rules between an XML type document and an original source document, specifically, rules pertaining to the node structure of the elements (See Bhatt, Column 14, lines 12-23). Bhatt also discloses verifying that the XML-type document is well-formed based on the data model (See Bhatt, Column 14, lines 30-44).

Eck and Bhatt are analogous art because they are from the same field of endeavor of translating documents from one format to another.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the mapping rules and verification of syntax of Bhatt with the file translation method of Eck. The motivation for doing so would have been to provide

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a generalized extraction and transformation process that can be used on various types of data from various sources (See Bhatt, Column 6, lines 33-38) Therefore, it would have been obvious to combine Bhatt with Eck for the benefit of to providing a generalized extraction and transformation process that can be used on various types of data from various sources to obtain the invention as specified in claims 1 and 21.

**As per dependent claims 2 and 22,** Eck and Bhatt disclose the limitations of claims 1 and 21 as described above. Eck also discloses creating an executable file to effect the translation between the XML-type document and the first type of document based on the data model for the XML-type document, the data model for the first type of document, and the mapping rules, and running the executable file to translate between the XML-type document and the first type of document. (See Eck, Page 1, paragraph 0003).

**As per dependent claims 3 and 23,** Eck and Bhatt disclose the limitations of claims 1 and 21 as described above. Eck also discloses translating test data based on the data model for the XML-type document, the data model for the first type of document, and the mapping rules (See Eck, Page 1, paragraph 0005), and verifying the propriety of the data model for the XML-type document, the data model for the first type of document and the mapping rules based on the result of the translation (See Eck, Page 6-7, paragraphs 0117-0132).

**As per dependent claims 7 and 27**, Eck and Bhatt disclose the limitations of claims 1 and 21 as described above. Eck also discloses receiving an indication of the direction of the translation (See Eck, Page 4, paragraph 0065, and Figure 5).

**As per dependent claims 8 and 28**, Eck and Bhatt disclose the limitations of claim 1 as described above. Eck also discloses including receiving an indication of the identity of the XML data source (See Eck, Figure 5).

**As per claims 9 and 29**, Eck and Bhatt disclose the limitations of claims 1 and 21 as described above. Eck also discloses that the XML data source is an XML Schema Definition (XSD) (See Eck, Page 1, paragraph 0019).

**As per dependent claims 10 and 30**, Eck and Bhatt disclose the limitations of claims 9 and 29 as described above. Eck also discloses providing a model for numerics in the XSD (See Eck, Page 6, paragraph 0117).

**As per dependent claims 11 and 31**, Eck and Bhatt disclose the limitations of claims 9 and 29 as described above. Eck also discloses providing a model for grouping and pattern definitions in the XSD (See Eck, Page 5, paragraphs 0088 and 0090).

**As per dependent claims 12 and 32**, Eck and Bhatt disclose the limitations of claims 9 and 29 as described above. Eck also discloses providing a model for field

lengths (See Eck, Page 5, paragraph 0087) and value ranges (See Eck, Page 4, paragraph 0076).

**As per dependent claims 13 and 33**, Eck and Bhatt disclose the limitations of claims 1 and 21 as described above. Eck also discloses creating a map component file, which identifies the data models for the XML-type document, and the first type of document (See Eck, Page 6, paragraphs 0113-0114), and where running the executable file includes referencing the map component file to perform the translation (See Eck, Page 6, paragraph 0115).

**As per dependent claims 14 and 34**, Eck and Bhatt disclose the limitations of claims 1 and 21 as described above. Eck also discloses receiving an indication of the identity of the XML-type document to be translated (See Eck, Figure 5).

**As per dependent claims 15 and 35**, Eck and Bhatt disclose the limitations of claims 1 and 21 as described above. Eck also discloses validating that the translation between the XML-type document and the first type of document is accurate (See Eck, Pages 6-7, paragraphs 0117-0132).

**As per dependent claims 16 and 36**, Eck and Bhatt disclose the limitations of claims 15 and 35 as described above. Eck also discloses receiving an indication of how to perform the validation (See Eck, Page 7, paragraph 0123).



**As per dependent claims 18 and 38**, Eck and Bhatt disclose the limitations of claims 1 and 21 as described above. Eck also discloses that the checking includes determining that each element in the XML-type document has start and end tags with the same label (See Eck, Page 7, paragraphs 0126-0127).

**As per dependent claims 20 and 40**, Eck and Bhatt disclose the limitations of claims 15 and 35 as described above. Eck also discloses that the validation also includes determining that elements in the XML-type document are in the correct order (See Eck, Page 6, paragraph 0113), determining that the XML-type document includes any specified mandatory elements (See Eck, Page 7, paragraph 0131), determining if data types in the XML-type document are proper (See Eck, Page 7, paragraph 0123), and determining if the format of a value in a field in the XML-type document is proper (See Eck, Page 7, paragraph 0128).

**As per independent claims 41 and 45**, Eck and Bhatt disclose the limitations of claim 1 as described above.

Eck also discloses a computer system for translating between an XML-type document and a first type of document including a processor, and a memory, coupled to the processor, including a number of instructions executed by the processor configured to perform the functionality disclosed in claim 1. (See Eck, Figure 2, and Page 2, paragraph 0037).

**Dependent claims 42 and 46 are rejected on the same basis as claim 2.**

**8. Claims 4, 24, 43, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eck (U.S. Publication 2002/0129059 A1) in view of Bhatt (U.S. Patent 6,799,184 B2, filed 30 January 2002, and claiming priority from U.S. Provisional application no. 60/300,573, filed 21 June 2001) as applied to claims 1, 21, 41, and 45 above, and further in view of Webber (U.S. Patent 6,418,400 B1).**

**As per dependent claims 4 and 24,** Eck and Bhatt disclose the limitations of claims 1 and 21 as described above. Eck also discloses modifying the data model for the first type of document to conform to a format associated with the first type of document (See Eck, Page 6, paragraph 0111). Eck and Bhatt do not disclose expressly modifying the mapping rules based on the modification of the data for the first type of document. Webber discloses modifying mapping rules using a Modify mode (See Webber, Column 7, lines 62-67, and Column 8, lines 1-6). Eck, Bhatt and Webber are analogous art because they are from the same field of endeavor of translating electronic documents. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the modification of mapping rules of Webber with the system and method of Eck and Bhatt. The motivation for doing so would have been to allow the user to create rules used for data validation (See Webber, Column 8, lines 7-9). Therefore it would have been obvious to combine Webber with

Eck and Bhatt for the benefit of allowing the modification of mapping rules for testing purposes to obtain the invention as specified in claims 4 and 24.

**Dependent claims 43 and 47 are rejected on the same basis as claim 4.**

9. **Claims 5 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eck (U.S. Publication 2002/0129059 A1) in view of Bhatt (U.S. Patent 6,799,184 B2, filed 30 January 2002, and claiming priority from U.S. Provisional application no. 60/300,573, filed 21 June 2001) and Webber (U.S. Patent 6,418,400 B1) as applied to claims 4 and 24 above, and further in view of Huang (U.S. Publication 2002/0147748 A1).**

**As per dependent claims 5 and 25,** Eck, Bhatt and Webber disclose the limitations of claims 4 and 24 as described above. Eck, Bhatt and Webber do not disclose expressly adjusting the data model for the first type of document to conform with an import utility of an application associated with the first type of document. Huang discloses using an import utility to edit associated meta-tag information for a file. (See Huang, Page 5, paragraph 0069). Eck, Bhatt, Webber and Huang are analogous art because they are from the same field of endeavor of translating electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the use of an import utility program of Huang with the system and method of Eck, Bhatt and Webber. The motivation for doing so would have been to allow for

simple creation of a file (See Huang, Page 5, paragraph 0069). Therefore, it would have been obvious to combine Huang with Eck, Bhatt, and Webber for the benefit of easily creating the file to obtain the invention as specified in claims 5 and 25.

**10. Claims 6, 26, 44, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eck (U.S. Publication 2002/0129059 A1) in view of Bhatt (U.S. Patent 6,799,184 B2, filed 30 January 2002, and claiming priority from U.S. Provisional application no. 60/300,573, filed 21 June 2001) as applied to claims 1, 21, 41, and 45 above, and further in view of De La Huerga (U.S. Patent 6,516,321 B1).**

**As per dependent claims 6 and 26,** Eck and Bhatt disclose the limitations of claims 1 and 21 as described above. Eck and Bhatt do not disclose expressly omitting formatting that is present in the data model for the XML-type document. De La Huerga discloses removing all XML tags from a document. (See De La Huerga, Column 27, line 21). Eck, Bhatt, and De La Huerga are analogous art because they are from the same field of endeavor of processing electronic data. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the omission of XML tags of De La Huerga with the system and method of Eck and Bhatt. The motivation for doing so would have been to ensure that tag enabled applications do not reference incorrect information from the data (See De La Huerga, Column 27, lines 26-27). Therefore, it would have been obvious to combine De La Huerga with Eck and

Bhatt for the benefit of providing accurate data to obtain the invention as specified in claims 6 and 26.

**Dependent claims 44 and 48** are rejected on the same basis as claim 6.

### ***Response to Arguments***

17. The affidavit filed on 7 July 2006 under 37 CFR § 1.131 has been considered but is ineffective to overcome the Bhatt (U.S. Patent 6,799,184 B2, filed 30 January 2002, and claiming priority from U.S. Provisional application no. 60/300,573, filed 21 June 2001) reference.

The DECLARATION OF PRIOR INVENTION UNDER 37 C.F.R. 1.131 attempts to show conception of the invention prior to the effective date of the Bhatt reference, 21 June 2001, coupled with due diligence from prior to the reference date to the priority date 27 December 2001 of the application (actual reduction to practice).

#### **I. Conception**

A) A conception of an invention, though evidenced by disclosure, drawing, and even a model, is not a complete invention under the patent laws, and confers no rights on inventor, and has no effect on a subsequently granted patent to another, **UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE**

DILIGENCE BY SOME OTHER ACT.

B) General allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23.23 O.G. 1224 (Comm'r Pat. 183). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131 .

C) The affidavit or declaration and exhibits must clearly explain **which facts or data** the application is relying on to show completion of his or her invention prior to the particular date.

D. The affidavit or declaration **must state FACTS and produce such documentary evidence and exhibits in support thereof** as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP j 715.07(c)), at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits **pointing out exactly what facts are established and relied on by applicant**. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964). (See MPEP 715.07)

## II. Diligence

A. Where conception occurs prior to the date of the reference, the reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 21 8, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.

B. The critical period in which diligence must be shown begins **just prior to the effective date of the reference 21 June 2001**, or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States

patent application). The declarations and exhibits that were demonstrated by the application merely allege that the applicant has been diligent (see the Declaration of Matthew Rozek, page 1, paragraph 2). Additionally, diligence has not been established for the critical period beginning just prior to the effective date of the reference, 21 June 2001.

C. The declarations and exhibits that were demonstrated by the application did not clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the priority filing date 27 December 2001 in determining the sufficiency of 37 CFR 1.131, the critical period in which diligence must be shown begin just prior to the effective date of the reference 21 June 2001 or activity ending with the date of a reduction to practice, either actual or constructive. Therefore, diligence and reduction to practice is not established. The affidavit is insufficient to overcome Bhatt (U.S. Patent 6,799,184 B2) according to 37 C.F.R. 1.131.

III. Furthermore, the Rozek declaration is deemed improper, as it has not been **signed by all** the inventors of the subject matter claimed (See MPEP 715.04).

### ***Conclusion***



**12. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have

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questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR

*William L. Bashore*  
**WILLIAM BASHORE**  
**PRIMARY EXAMINER**